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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,711	07/16/2003	Weiling Peng	HARD1.063A	9592
60148 7590 03/07/2007 GARDERE / JAMES HARDIE GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201			EXAMINER GILBERT, WILLIAM V	
			ART UNIT	PAPER NUMBER
			3635	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/07/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/620,711

Applicant(s)

PENG, WEILING

Examiner

William V. Gilbert

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 and 23-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/26/04;03/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 3635

***Claim Objections***

2. **Claims 20 and 21** are objected to because of the following informalities: lack of antecedent basis. Applicant claims the products stacked "face-to-back" (Claim 20) and "face-to-face or back-to-back" (Claim 21). Applicant does not define a "face" or "back" of the product. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 2, 6-8, 18 and 22** are rejected under 35

U.S.C. 102(e) as being anticipated by Weiss (U.S. Patent No. 6,949,160).

Claim 1: Weiss discloses a protected pre-finished fiber cement product (Fig 1; Column 4, lines 60-65), with a finish layer (16) applied to the product, a protective layer (22)

Art Unit: 3635

**DETAILED ACTION**

This is a First Action on the Merits. Claims 1-70 are pending. Claims 9-14, and 23-70 are withdrawn from consideration. Claims 1-8 and 15-22 are examined below.

***Election/Restrictions***

1. Applicant's election without traverse of Claims 1-22 and 43-55 in the reply filed on 16 February 2007 is acknowledged.

Applicant's election with traverse of Species 1A (Claims 1-8 and 15-22) in the reply filed on 16 February 2007 is acknowledged. The traversal is on the ground(s) that Examiner did not state why each species is independent and distinct and that examination of all species do not pose a serious burden on the Examiner. This is not found persuasive because in the Action dated 18 January 2007, Examiner stated that the "spacer" in each embodiment is a different embodiment (page 4). The result of each different embodiment, five total, would result in a serious burden on the Examiner because each would require a separate search.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 3635

adhered to the finished layer, the protective layer protects the finish layer, the protective layer leaves no residue when removed, and the layer resists tearing on removal (inherent).

Claim 2: the protective layer is adhered to the finish with an adhesive (the fact that the layer is adhered to the product means an adhesive is involved.)

Claims 6-8: the protective layer is a polymer (Column 14, lines 25, 26, per Claim 6), and is polyethylene (Claims 7 and 8).

Claim 18: Weiss discloses a plurality of pre-finished fiber cement products (Column 3, lines 39-42), a finish layer (Fig. 1: 16) applied to the product, and a protective layer (22) applied to the finish layer where the protective layer protects the finish layer from damage in storage, removing the layer leaves no residue on the finish layer, and the layer resists tearing on removal (inherent).

Claim 22: the products are banded together (Column 3, lines 42-44).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3635

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 15-17, 19-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss.

Claim 15-17: Weiss discloses the claimed invention except for the limitations on the thickness of the protective layer (22). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these limitations because Applicant does not have a criticality for the necessity of these limitations and the prior art of record is capable of being made in such a

Art Unit: 3635

manner. Further, the fact that the claims state "about [dimension]" shows lack of criticality.

Claim 19: Weiss discloses the claimed invention including the products are stacked (Column 3, line 40), but not on a pallet. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to stack the products on a pallet because it is well known in the art to stack such products on pallets to ease in transportation and storage.

Claims 20 and 21: Weiss discloses the claimed invention except for the orientation of the stacked products. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to stack the materials in the manner in the claims because since a protective coating is on the material, the aesthetic surface will not suffer damage from placing a product on top of it.

**Claims 3-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss in view of Buckwater (U.S. Patent No. 6,599,599).

Claims 3 and 4: Weiss discloses the claimed invention except that the adhesive is an ethylene acrylic acid. Buckwater discloses a product (Fig. 1) with a removable layer (20) and an

Art Unit: 3635

adhesive layer (18) of ethylene acrylic acid (Column 4, line 64). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use this adhesive to adhere the protective layer to the product in Weiss to insure that the layer did not unexpectedly remove itself.

Claim 5: Weiss disclose the claimed invention except that the adhesive layer is between the finish layer and protective layer. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to place the adhesive between the finish layer and protective layer because the purpose of the adhesive is to adhere the protective layer to the finish layer.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Teare (U.S. Patent No. 4,434,119).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be



Art Unit: 3635

reached on 571.272.6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WVG

05/16/07

Paul [Signature]  
2011/11/16 10:20 AM  
2011/12/14 10:35 AM  
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